

R E M A R K S

By this Amendment the specification has been amended to include standard topic headings and to otherwise better comply with U.S. patent practice.

In the outstanding Office Action the examiner has (1) rejected claims 9, 13, 14 and 17 under 35 U.S.C. 102(b) as being anticipated by Adams, and (2) objected to claims 10-12, 15 and 16 as being based on a rejected claim (however, he indicates that these claims contain allowable subject matter).

The applicant thanks the examiner for his indication of allowable subject matter in claims 10-12, 15 and 16. At the same time, the applicant asserts that the rejection of claim 9, 13, 14 and 17 over Adams is in fact incorrect.

The earplug depicted in Fig. 6 of Adams has a bore that is stepped at 33 to provide a single end stop position for the mounting assembly 36. See column 4, lines 41 to 44: "The distal portion of lumen 32 tapers slightly inward . . . toward the distal end to provide a wedging watertight seal with the opposed surface of the mounting assembly 36." Consequently, external water pressure acts to urge the mounting assembly against the end stop position defined by the shoulder of the stepped bore.

In contrast to what the examiner alleges, the earplug depicted in Fig. 6 of Adams does not disclose a movable element. The membrane 34 is not a movable element, but is fixed in the mounting assembly 36.

Indeed, at lines 37 to 39 of column 4, Adams states that, "In the actual assembly membrane 34 and supporting frame 35 would be welded or sealingly affixed across lumen 38 in mounting assembly 36."

The mounting assembly 36 can be removed from the body 26 when the earplug is removed from the ear canal by inserting a blunt object into lumen 32 from the distal end 28 and pressing against the membrane or its support frame. After removal, a different mounting assembly 36 holding a membrane or membranes with different parameters can be reinserted into the proximal end of body 26. See lines 50 to 56 of column 4.

The mounting assembly 36 has a fixed position in the body 26 by virtue of being urged against the shoulder 33 in the stepped bore by external water pressure. The channel through the mounting assembly 36 is shown as having a uniform internal diameter, that is to say, the cross-section progress of the channel does not change. Hence, the attenuation of sound in the Adams device is attributable solely to the membrane or membranes and has nothing to do with the channel length or a change in cross-sectional progress. The slight taper of the distal portion 32B of lumen 32 is immaterial to sound attenuation in the Adams device because it does not affect the internal diameter of the mounting assembly 36.

Note that the clearances between the parts as depicted in Figs. 5, 5A and 6 are exaggerated to permit distinguishing between the various parts. See lines 34 and 35 of column 4. Therefore, in reality, there is no

clearance between the internal surface of the body 26 and the external surface of the mounting assembly 36.

The examiner has only been able to give his current interpretation to the Adams reference because of foreknowledge of the instant invention. He would not have been able to interpret the reference in this way if he had read it in isolation and if he had given proper weight to the particular description from lines 9 to 57 of column 4. Hindsight analysis is not a proper basis for an obviousness objection and we cannot see that it is any more legitimate to use hindsight analysis to formulate a novelty rejection. There is no intervening art which would support the interpretation that the examiner is using.

It is requested that the examiner's rejection based on Adams be withdrawn and all of claims 9-17 allowed.

Respectfully submitted,

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